

REMARKS

With entry of this amendment, claims 1-9 and 11-15 remain pending in the application. Claims 16-19 have been canceled as being directed to a plastic key cover. Claims 1 and 11 have been amended to address the formalities resulting in claim objections as detailed in Paper No. 20070406, page 2, first paragraph. Support for these amendments is found in the claims and figures as originally filed, and as such it is submitted that no new matter has been added by way of these amendments.

Currently, claims 1-4, 6, 8, 9 and 12-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over DM/059931 in view of Cicourel, Ridgway (US 1,794,498), and Rafter, all previously of record. The DM reference is cited as teaching the basic features of the claimed invention inclusive of a key head cover having sidewall apertures in registry with the opening of a key head, an outer wall having edges spaced from the bottom edges of the first and second sidewalls, and tactile features on both sidewalls as well as on the bottom edges of the sidewalls with reference to Figs. 6.2, 6.3, 2.2 and 2.3 of the DM reference. Fig. 6.3 is noted in particular as showing a house icon. Applicant notes with appreciation the Examiner's recognition that the DM reference does not provide a tactile feature integrally formed on the plane of the first sidewall as was previously detailed in Paper No. 20061129. Consistent with this recognition Cicourel is cited for teaching a tactile feature with regard to reference numeral 5 on the sidewall, with the tactile feature secured throughout the rear contact plane with the plane of the sidewall and formed as a single material with a key head cover. Ridgway is cited for a teaching of a key head cover with respect to Figure 3. Such an aperture is aligned with a key head opening and retaining that position only by a key ring passing therethrough. Lastly, Rafter is cited for

teaching that a key head cover 12 with reference to Figure 5 includes a house icon which may be formed from metal.

The basis of the rejection is that:

It would have been obvious to form the tactile features of the DM reference as being secured throughout their rear contact plane to the plane of the sidewalls, and as a single material with the sidewalls, in view of the teaching of Cicourel, the motivation being to optimize the strength of the connection between the tactile features and the sidewall. It would have been obvious to modify the key head cover of the DM reference such that it has its apertures aligned with a key head only by a key ring, in view of the teaching of Ridgway, the motivation being to simplify the sliding installation of the key head cover on a key head. It would have been obvious to form the key head cover of the DM reference as modified by Cicourel, to be formed from metal, in view of the teaching of Rafter, the motivation being to optimize the strength of the cover.

The prior art must teach or suggest all the claim limitations. To establish *prima facie* obviousness of a claimed invention, all of the claimed inventions must be taught or suggested in the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). With respect to the recitation of claim 1, these include forming the key cover with a tactile feature integral throughout the rear contact plane with a first sidewall from metal. Discussions made of record in the amendment of March 21, 2007 pertaining to a discussion of molding a key head cover were not provided to imbue claim 1 with process limitations but rather highlight the technical difficulties posed by the prior art reference combination of the DM reference with Cicourel that are so great as to destroy the motivation for such a combination for one of ordinary skill in the art. Applicant's discussion of the process requirements of the DM reference and Cicourel are relevant with respect to the issue as to whether the references are combinable. That is, if a proposal for modifying the prior art in an effort to attain the claimed invention causes the art to

become inoperable or destroys its intended function, then the requisite motivation to make the modification would not have existed. See *In re Fritch*, 972 F.2d 1260, 1265 n. 12, 23 USPQ2d 1780, 1783 n.12 (Fed. Cir. 1992).

As it is well-established law that a teaching, suggestion or incentive supporting the prior art reference combination must be found to support a *prima facie* obviousness rejection of a claimed invention and such is not present here per *In re Geiger*, 815 F.2d 686, 2 USPQ2d 276 (Fed. Cir. 1987), claim 1 and those claims that depend therefrom are submitted to be patentable.

The basis of the outstanding rejection is that the motivation to combine the DM reference with the teaching of Cicourel would be “to optimize the strength of the connection between the tactile features and the sidewall” (Paper No. 20070406, page 3). Concerning the context of the use of a key cover and the evidence of record that the DM reference brazed tactile features to a key cover sidewall, it is submitted that one of ordinary skill in the art would consider brazing a metal feature to a metal key cover sidewall to be more than adequate to retain the tactile feature on the sidewall for the life of the key cover as a key cover in normal use is exposed to only nominal shear forces across the plane of the sidewall. In addition to the adequacy of the DM reference to secure the tactile feature in the eyes of one of ordinary skill in the art, the added complexity of creating an inventive key cover in which the tactile feature is integral with the sidewall along the back plane in total is submitted to remove motivation for the combination of the DM reference and Cicourel. In support of this position, Applicant hereby incorporates by reference the remarks made of record in the March 21, 2007 amendment found on pages 10-13 of that amendment.

In summary, it is respectfully submitted that one of ordinary skill in the art would find the DM reference adequate in strength as to retaining a tactile feature on the sidewall of a key cover.

The fact that Cicourel only teaches formation of a key cover from a rubber or other elastomeric material (lines 29-31), not a metal as presently claimed, should be properly weighed in that while a rubber key cover with integral tactile features on the sidewall is readily formed, doing so in metal as required by pending independent claim 1 makes the formation of an inventive key cover something that one of ordinary skill in the art would lack a motivation to perform especially since the strength of the DM reference would be considered to be adequate.

It is also improper to combine references where the references teach away from their combination. *In re Griselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). With respect to pending independent claim 1, this claim includes the recitation that the head of the key is inserted within a recess of the key cover "so that an opening in the head remains aligned with the key cover only by the key ring passing simultaneously therethrough" (claim 1, lines 11-13). In contrast to pending independent claim 1, Rafter in teaching an all metal key cover in form in fact forms the casing (reference numeral 12 as shown in Fig. 5) from a malleable metal that is indented into a collar 24 and therefore represents a retention of the key cover not by a key ring as the only means of retaining the key cover in position. Further, Rafter wholly lacks an aperture through which a key ring could be inserted. Additionally, as previously made of record and as shown in Fig. 6, Rafter teaches a multi-layer key cover but teaches away from a tactile feature integral with the sidewall throughout the back plane as well as the alignment retention between the key and the surrounding key cover being only through a key ring inserted therethrough.

Ridgeway provides nothing to bolster the above highlighted limitations of the prior art reference combination and potentially affords an additional teaching away in that Figs. 4 and 5 of Ridgeway appear to show a friction fit between the interior of sidewalls 2 and 3 and the contacting planar surfaces of the key detailed with respect to reference numeral 7.

In light of the above remarks, reconsideration and withdrawal of the rejection as to claims 1-4, 6, 8, 9 and 12-15 under 35 U.S.C. §103(a) over the DM reference in view of Cicourel, Ridgeway and Rafter is requested.

Remarks Directed to Rejection of Claim 7 under 35 U.S.C. §103(a)

Claim 7 is submitted to be allowable on the basis of dependency from claim 1 by claim 6 based on the above remarks.

In light of these remarks, reconsideration and allowance of claim 7 is requested.

**Remarks Directed to Rejection of Claim 11 under 35 U.S.C. §103(a)
over References as Applied to Claim 1 and Further in View of Sheldon**

The basis of this rejection is that Sheldon teaches a key ring securement for multiple keys with multiple identifiers as detailed with respect to reference numerals 18 and 18a, citing column 3, lines 9-11. Paper No. 20070406, page 4, third paragraph, goes on to state:

It would have been obvious to utilize multiple keys of the DM reference as modified by Cicourel, Ridgeway and Rafter, with different tactile features located on the same key ring, in view of the teaching of Sheldon, the motivation being to allow an individual to carry multiple keys and distinguish the keys by their tactile features.

While Rafter clearly contemplates the notion of individual key identifiers, the elements used to achieve identification are submitted to teach away from the prior art combination and in fact lacks recitations of pending claim 11. Specifically, the spring clip 20 of Sheldon is contrary to the recitations of claim 1 in that only the key ring retains the key in position relative to the key cover (see Fig. 1, column 3, lines 20-23) and additionally that the tactile feature be integral along the back face with the sidewall of the key cover. As such Applicant submits that the limitations of claim 1 integral to pending claim 11 are not only not found in the prior art reference combination, but further that these limitations are taught away from by the prior art.

Additionally, while the present invention of claim 11 provides a large number of tactile descriptors for distinguishing keys between adult and child, a sighted person and a visually impaired person, and the like as detailed in the specification at page 1, lines 12-15, only through resort to a key cover surrounding a key head, proximately analogous to the spring 20 of Sheldon, Sheldon requires elongated tab 12 as well as a unique identifier 18, 18A, or 18B. The fact that the claimed invention provides an equivalent functionality with one element instead of three necessarily constitutes a patentable improvement and in fact a surprising result in light of the prior art references of record.

In light of the above remarks, reconsideration and withdrawal of the rejection of claim 11 under 35 U.S.C. §103(a) is requested.

Remarks Directed to Rejection of Claim 5 under 35 U.S.C. §103(a)

The basis of the rejection is that with respect to claim 1 and further relies on Figs. 8.2 and 9.3 of the DM reference to show raised geometric shapes and depressed geometric shapes, respectively, while Figs. 2.2 and 2.3 of the DM reference teach multiple geometric shapes provided on the same sidewall.

In regard to this rejection, Applicant relies on the above remarks made with respect to the rejection of claim 1 to rebut the rejection. Additionally, Applicant submits that the combination of features found within the DM reference is highly speculative. The DM reference lacks written description altogether and instead merely represents a collection of industrial designs. As the DM reference is wholly devoid of written description, such a combination of elements is respectfully submitted to constitute a hindsight reconstruction. Such hindsight reconstruction has long been established to represent an improper basis for a *prima facie* case of obviousness.

In light of the above remarks, reconsideration and withdrawal of the rejection as to claim 5 under 35 U.S.C. §103(a) is requested.

Summary

Claims 1-9 and 11-15 remain pending in this application. Each claim is believed to be in allowable form and directed to patentable subject matter. Reconsideration and withdrawal of the outstanding rejections and the passing of this application to allowance are solicited.

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Respectfully submitted,

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